

## REMARKS

The issues outstanding in the office action mailed January 10, 2006, are the rejections under 35 U.S.C. §§ 112 and 102. Reconsideration of these issues, in view of the following discussion, is respectfully requested.

### Rejections under 35 U.S.C. §112

Claims 1-12 have been rejected under 35 U.S.C. §112, first paragraph. Reconsideration of this rejection is respectfully requested.

It is argued, at page two of the office action, that the specification does not reasonably provide enablement for compounds of the invention with only three rings in formula II (i.e., f=0). The office action does not explain why such compounds would be non-enabled, and it is submitted that one of the skilled in the art would clearly understand how to prepare such compounds, in analogy to the disclosed preparations of the four ring compounds. In any event, in order to expedite prosecution, the claims have been amended so that f is 1. Withdrawal of the rejection is respectfully requested.

Claims 1-3, 6-7 and 9 have been rejected under 35 U.S.C. §112, second paragraph. Reconsideration of this rejection is also respectfully requested.

It is argued, at page two of the office action, that various other claims are indefinite inasmuch as there is overlap between certain other formulas. It is respectfully submitted that the potential existence of double inclusion does not, *per se* render claims indefinite. First, it is no longer the official position of the PTO that double inclusion is *per se* impermissible. See, for example, M.P.E.P. §2173.05(o). It is respectfully submitted that one of the ordinary skill of the art has no difficulty in interpreting the formulae of the claims, and that there is no indefiniteness present from the mere arguable possibility of overlap. Moreover, with respect to the perceived overlap between formula I and II, in view of the above noted amendments such overlap is not seen to be present. In any event, it is submitted that claims satisfy the requirements of 35 U.S.C. §112, and withdrawal of the rejection is respectfully requested.

Claim 11 has been rejected 35 U.S.C. §101. It is submitted that the claim was in view of claim, and the claim has been cancelled.

Rejections under 35 U.S.C. §102

Claims 1-7 and 10-12 have been rejected under 35 U.S.C. §102(b) over Kondo'603 or EP'231. Reconsideration of this rejection is respectfully requested.

Formula (1), noted at page 3 of the office action, is a generic formula, with a vast number of species therein, see column two, lines 15-48. It is clear that such a generic formula, without more, cannot anticipate the present claims. See, for example, *In re Ruschig*, 343 F.2d 965, 145 U.S.P.Q. 274 (C.C.P.A. 1965). The office action at page three cites examples 6-7, 15-18, 21-23, 25 and 27-30. It is evident from the examples cited at page three of the office action that the compounds in accordance with patentees invention thus exemplified all contain a polar group X, i.e., a chlorine or fluorine atom or a trifluoromethoxy group. It is thus respectfully submitted that these examples do not anticipate a compound bearing two non-polar, i.e., alkyl, wing groups. It is thus respectfully submitted that the '603 patent does not anticipate the indicated claims.

It is moreover respectfully submitted that the '603 patent does not suggest the present claims, inasmuch as it clearly teaches to one of ordinary skill in the art are the need to employ a polar wing group. One of ordinary skill in the art thus lacks the requisite motivation to select a non-polar wing group from the disclosure of the '603 patent. The examples of the present application show that the use of compounds in formula II, having non-polar alkyl wing groups, enables increasing the voltage holding ratio of a liquid crystalline mixture.

Accordingly, it submitted that the '603 patent neither anticipates nor suggests the present claims, and withdrawal of this rejection is respectfully requested.

Claims 1-6 and 9-12 have been rejected under 35 U.S.C. §102(b) over Tanaka'828. Reconsideration of this rejection is also respectfully requested. Tanaka neither discloses nor exemplifies compounds wherein four phenyl rings and two alkyl wing groups are contained.

Note that one of Q<sup>1</sup> and Q<sup>2</sup> must be a single bond, see column 5, lines 1-3. The patent clearly neither discloses or suggests compounds of formula II in the present application. Withdrawal of this rejection is respectfully requested.

Claims 1-8 and 10-12 have been rejected under 35 U.S.C. §102(e) over Heckmeier'056. Reconsideration of this rejection is respectfully requested. It is noted that the following comments also pertain to any publication of PCT/EP00/12891 which might constitute a reference under 35 U.S.C. §102. Heckmeier also neither discloses nor suggests compounds having four phenyl rings and two alkyl wing groups. It is not seen that the generic disclosure of the application encompasses same; the examples do not exemplify same. Accordingly, it is submitted that this rejection should also be withdrawn.

The claims in the application are submitted to be in condition for allowance. However, should the examiner have any questions or comments, he is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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